UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
PARK, JEONG S

ART UNIT	PAPER NUMBER
2154	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/529,405	SCHEERING, CHRISTIAN
	Examiner	Art Unit
	JEONG S. PARK	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/2/2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17,18,20,26-28,30,31 and 33-44* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *17, 18, 20, 26-28, 30, 31 and 33-44* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *29 March 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2

January 2008 has been entered.

Claim Objections

2.   Claims 17, 18, 20, 37-40, 42 and 43 are objected to because of the following

informalities:

        In claim 17, line 10, the phrase "the address server" should be corrected as –the

domain name system server-- for clear understanding of the claim.

        Appropriate correction is required.

3.   Claim 36 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

        Because the claim 32 has been cancelled by the applicant's amendment.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 17, 20, 26-28, 30, 33-39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golla et al. (hereinafter Golla)(U.S. Patent No. 6,587,874 B1) in view of O'Toole et al. (hereinafter O'Toole)(U.S. Patent No. 6,345,294 B1).

Regarding claims 17, 26 and 28, Golla teaches as follows:

A method for configuring a device in a data network (see, e.g., col. 1, lines 40-44), comprising:

storing a domain name of the device (network device 12 in figure 1) in the device, the domain name input manually on the device by an administrator (since the network device is connected with a local network (14 in figure 1), log-in by a user as inputting a domain name, user ID and password is inherent (see, e.g., col. 2, line 65 to col. 3, line 6);

transmitting a request message (207 and 232 in figure 2A) comprising the stored domain name to a domain name system server (DHCP server 24 and DNS server 240 in figure 2A) by the device (network device 12 in figure 2A), wherein the domain name system server is used to convert between domain names and Internet protocol addresses (DHCP server provides IP addresses based on the network device request and DNS server provides network device name per the IP addresses attained, see, e.g., col. 6, lines 10-22 and figure 2A, 207, 211, 232 and 234) and to look up address information of a parameter server (LDAP server 26 in figure 2A) based on the transmitted domain name (network device name)(TFTP server 242 in figure 2A

response to the network device sending out a file contains information about the closest

LDAP server, see, e.g., col. 6, lines 23-30 and see, figure 2A, 236 and 238);

receiving a response message from the addressing server (TFTP server 242 in

figure 2A) by the device, the response message comprising the looked up address

information of the parameter server (LDAP server 26 in figure 2A)(TFTP server 242 in

figure 2A response to the network device sending out a file contains information about

the closest LDAP server, see, e.g., col. 6, lines 23-30 and see, figure 2A, 236 and 238);

setting up a connection to the parameter server by the device, the device using

the address information to set up the connection (see, e.g., col. 6, lines 31-45 and see,

figure 2A, 215 and 219); and

receiving parameters by the device from the parameter server, wherein the

parameters are used to configure the device (see, e.g., col. 7, lines 12-29 and see,

figure 2A, 223 and 227).

Golla teaches all limitations of claim with utilizing a plurality of servers (DHCP,

DNS and TFTP servers) instead of utilizing the claimed one domain name system

(DNS) server.

It would have been obvious for one of ordinary skill in the art at the time of the

invention to combine three servers (DHCP, DNS and TFTP servers) as taught by Golla

into one DNS server in order to efficiently centralize multiple functionalities together.

Even though Golla implicitly teaches inputting domain name along with user ID

and password for a LAN connection as explained above.

O'Toole teaches as follows:

A SODA appliance is configured with a global unique number and with a DNS name for a server that hosts the appliance registry that contains information to configure the appliance (see, e.g., col. 6, lines 26-38).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Golla to include a step of inputting a domain name in the configuring appliance as taught by O'Toole in order to properly connect to the server contains all the configuration information of the configuring appliance.

Regarding claim 20, Golla teaches as follows:

The address information is stored in the domain name system server in a text field of a data record associated to the domain name, and wherein the text field (TFTP server 242 in figure 2A response to the network device sending out a file contains information about the closest LDAP server, see, e.g., col. 6, lines 23-30 and see, figure 2A, 236 and 238) is sent to the device in the response (TFTP reply 266 in figure 2B includes a domain name for a directory having the device's configuration parameters, see, e.g., col. 7, lines 64-67 and see, e.g., figure 2B, 266).

Regarding claim 27, Golla teaches as follows:

The addressing server (TFTP server 242 in figure 2A or 252 in figure 2B) uses data records to store the Internet protocol addresses of the associated parameter servers (LDAP server 26 in figure 2A or Directory 254 in figure 2B) for the respective names of domains (TFTP server provides IP address of LDAP server to the network device, see, e.g., col. 6, lines 23-35), wherein the address information related to the parameter server associated with the device is stored in a text field which belongs to a

data record which belongs to the domain name associated with this device, and wherein

the text field is sent to the device as the response (TFTP server 242 in figure 2A

response to the network device sending out a file contains information about the closest

LDAP server, see, e.g., col. 6, lines 23-30 and see, figure 2A, 236 and 238).

Regarding claims 30 and 33, Golla teaches as follows:

An arrangement for configuring a device in a data network, the device having a

memory, the arrangement comprising:

an addressing server (DNS server 240 in figure 2A) for converting between

domain name and an Internet protocol address (see, e.g., col. 6, lines 16-22); and

a parameter server (LDAP server 26 in figure 2A) for storing parameters which

can be used to configure the device for operation in the data network (see, e.g., col. 7,

lines 13-29), wherein the device (network device 12 in figure 1 and figure 2A), the

addressing server, and the parameter server are connected via the data network (14 in

figure 1), wherein the device is designed to:

store a fully-qualified domain name associated with the device (234 in figure 2A,

see, e.g., col. 6, lines 16-22), and

transmit a request message to the addressing server (236 in figure 2A or 264 in

figure 2B), said request message comprising the fully-qualified domain name stored in

the device (see, e.g., col. 6, lines 16-22),

wherein the addressing server (DNS and TFTP servers) is designed to:

use the fully-qualified domain name transmitted by the device (the network

device have the domain name from the DNS server, see, 234 in figure 2A) to look up a

text field associated with the transmitted domain name, text field having address

information of the parameter server (TFTP broadcast 236 in figure 2A requests to find

LDAP server based on the network device domain name, see, e.g., col. 6, lines 23-30),

the address information including a port number form a response message

comprising the looked address information of the parameter server assigned to the

device (when communicates with IP address, it is inherent to include the well-known

port number),

the response message transmitted to the device in response to the request

message (236 and 238 in figure 2A),

wherein the device is further designed to connect to the parameter server based

the response message (215 and 219 in figure 2A, see, e.g., col. 6, lines 31-45), and

wherein the parameter server is adapted to send parameters to the device (227

in figure 2A, see, e.g., col. 7, line 66 to col. 7, line 29).

Golla teaches all limitations of claim with utilizing a plurality of servers (DHCP,

DNS and TFTP servers) instead of utilizing the claimed one addressing server.

It would have been obvious for one of ordinary skill in the art at the time of the

invention to combine three servers (DHCP, DNS and TFTP servers) as taught by Golla

into one DNS server in order to efficiently centralize multiple functionalities together.

Even though Golla implicitly teaches inputting domain name along with user ID

and password for a LAN connection as explained above.

O'Toole teaches as follows:

A SODA appliance is configured with a global unique number and with a DNS

name for a server that hosts the appliance registry that contains information to configure

the appliance (see, e.g., col. 6, lines 26-38).

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Golla to include a step of inputting a domain name in the configuring

appliance as taught by O'Toole in order to properly connect to the server contains all

the configuration information of the configuring appliance.

Regarding claim 34, Golla teaches as follows:

a DHCP server connected to the device via the data network and designed to

send the domain name to the device using a DHCP method after said device has been

started up, the domain name being that domain name which is used by the device in the

request message (DHCP provide IP address for the network device and the DNS server

provides a domain name for the network device based on the IP address, see, e.g., col.

6, lines 6-22).

Regarding claim 35, Golla teaches as follows:

The device is assigned to a domain in the data network, and the domain name

sent in the request message is a name of this domain (see, e.g., col. 6, lines 6-22).

Regarding claim 36, Golla teaches as follows:

In the addressing server is stored the data record with a fictitious domain name

(local domain name) which does not belong to a real domain (unique domain name from

DNS server), and wherein the fictitious domain name is simultaneously stored as

domain name in the memory of devices in which no domain name for the real domain

associated therewith is stored (the network device stores the local domain name until DSN server provides the unique domain name based on the IP address of the network device, see, e.g., col. 3, lines 21-27).

Regarding claims 37 and 44, Golla teaches as follows:

The stored domain name is a fully-qualified domain name (interpreted as a unique domain name)(domain name from the DNS server provides unique domain name for each network device is well-known in the art, see, e.g., col. 3, lines 21-27).

Regarding claim 38, Golla teaches as follows:

The address information is a domain name of the parameter server (directory 254 in figure 2B or LDAP server 26 in figure 2A)(the reply from TFTP server includes a domain name for a directory having the device's configuration parameters, see, e.g., col. 7, lines 64-67).

Regarding claim 39, Golla teaches as follows:

The domain name of the parameter server is a fully-qualified domain name (Domain name of the Directory 254 (equivalent to applicant's parameter server) is provided from the DNS server 256 in figure 2B, see, e.g., col. 8, lines 1-14 and see, e.g., 270 and 272 in figure 2B).

6.   Claims 18, 31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golla et al. (hereinafter Golla)(U.S. Patent No. 6,587,874 B1) and O'Toole et al. (hereinafter O'Toole)(U.S. Patent No. 6,345,294 B1) in view of Skemer et al. (hereinafter Skemer)(U.S. Patent No. 6,570,849 B1).

Regarding claims 18 and 31, Golla teaches all the limitations of claims 17 and 30 as explained above except for using voice over Internet protocol on the data network.

Skemer teaches as follows:

The Voice over IP gateway for converting telephony and other voice-band signals and signaling information into IP packets over an access network, which is an established packet based network (see, e.g., col. 7, line 65 to col. 8, line 4 and figure 1).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Golla to use data network for voice data on the basis of the Internet protocol as taught by Skemer in order to utilize existing data network capacity by interleaving voice IP traffic onto the current data traffic.

Regarding claim 40, Golla teaches as follows:

At least one of the parameters received from the parameter server pertains to a transmission of the voice information (the network device includes voice gateways and PBX, see, e.g., col. 4, lines 1-13).

7.   Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golla et al. (hereinafter Golla)(U.S. Patent No. 6,587,874 B1), O'Toole et al. (hereinafter O'Toole)(U.S. Patent No. 6,345,294 B1) and Skemer et al. (hereinafter Skemer)(U.S. Patent No. 6,570,849 B1) in view of Choudhry (U.S. Patent No. 6,442,602 B1).

Regarding claims 41 and 42, Golla teaches all the limitations of claims 17, 26 and 30 and implicitly includes local domain name and a unique (global) domain name (see, e.g., col. 6, lines 6-22).

Choudhry further teaches as follows:

Fictitious domain (virtual subdomain name, 53 in figure 5) name does not belong to a real domain (URL is not recognized by the standard DNS is called as the virtual subdomain name, 51 in figure 5, see, e.g., col. 6, lines 36-40 and fig 4);

Both the fictitious domain name (virtual subdomain name, 53 in figure 5) and a real domain name (known domain name, 50 in figure 5) are used (see, e.g., col. 6, lines 53-62 and figure 5);

A first attempt is used to transmit the request message (41 in figure4) with the real domain name (known domain name, 50 in figure 5) to the addressing server (DNS), if no address information can be ascertained in the addressing server using the domain name transmitted in the first attempt then the addressing server sends a negative acknowledgement message (error 404, 42 in figure 4) to the device as address information (web browser requests URL. If the URL is not recognized by the DNS, the server will return a "error 404:file not found" page to the web browser, see, e.g., col. 6, lines 36-40 and fig 4); and

A terminal using a second attempt send a further request message with the fictitious domain name (virtual subdomain name, 53 in figure 5) to the addressing server (see, e.g., col. 6, lines 58-62 and 53 in figure 5).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Golla to include using a fictitious domain name and a real domain as domain name in the process of getting IP addresses from domain names by DNS as taught by Choudhry in order to provide more reliable domain naming service for directing multiple possible domain names to the correct IP address.

Regarding claim 43, Golla teaches as follows:

The real domain name (domain name from the DNS server) is a fully-qualified

domain name (DNS server provides unique domain name for each network device is

well-known in the art, see, e.g., col. 3, lines 21-27).

Double Patenting

8.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
        The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9.   Claims 17, 26, 30 and 31 are provisionally rejected under 35 U.S.C. 101 as

claiming the same invention as that of claims 15, 27 and 28 of copending Application

No. 10/884,485 (hereinafter '485). Because the copending application teaches all the

limitations of the applicant's claims as listed above.

Regarding claims 17 and 26, '485 teaches as follows:

A method for configuring a device in a data network comprising (see, e.g., claim 15, lines 1-2);

transmitting a request message comprising the stored domain name to a domain name system server by the device, wherein the domain name system server is used to convert between domain names and Internet protocol addresses and to look up address information of a parameter server based on the transmitted domain name (see, e.g., claim 15, lines 5-7);

receiving a response message from the addressing server by the device, the response message comprising the looked up address information of the parameter server(see, e.g., claim 15, lines 8-11);

setting up a connection to the parameter server by the device, the device using the address information to set up the connection(see, e.g., claim 15, lines 12-13);

receiving parameters by the device from the parameter server, wherein the parameters are used to configure the device(see, e.g., claim 15, lines 14-16); and

'485 teaches storing a predetermined address of an address assignment server while the applicant claims storing a domain name of the configuring device.

Therefore, the applicant's domain name and the predetermined address of '485 does not need to the same address even though it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the predetermined address as a domain name.

Regarding claims 30 and 31, '485 teaches as follows:

An arrangement for configuring a device in a data network, the device having a memory, the arrangement comprising (see, e.g., claim 27, lines 1-3):

an addressing server for converting between domain name and an Internet protocol address (see, e.g., claim 27, line 4);

a parameter server for storing parameters which can be used to configure the device for operation in the data network, wherein the device, the addressing server, and the parameter server are connected via the data network (see, e.g., claim 27, lines 7-10);

wherein the device is designed to:

store a fully-qualified domain name associated with the device, and transmit a request message to the addressing server, said request message comprising the fully-qualified domain name stored in the device (see, e.g., claim 27, lines 11-13);

wherein the addressing server is designed to:

use the fully-qualified domain name transmitted by the device to look up a text field associated with the transmitted domain name, text field having address information of the parameter server, the address information including a port number form a response message comprising the looked address information of the parameter server assigned to the device, the response message transmitted to the device in response to the request message (see, e.g., claim 27, lines 14-16);

wherein the device is further designed to connect to the parameter server based the response message (see, e.g., claim 27, lines 17-18);

wherein the parameter server is adapted to send parameters to the device (see, e.g., claim 27, line 19); and

the data network is a voice (speech) data network in which voice information is sent in data packets on the basis of an Internet protocol (see, e.g., claim 28, lines 1-3).

This is a <u>provisional</u> double patenting rejection since the conflicting claims have not in fact been patented.

Response to Arguments

10.   Applicant's affidavit filed on 29 November 2007 has been considered but are moot in view of the new ground(s) of rejection presented above.

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEONG S. PARK whose telephone number is (571)270-1597. The examiner can normally be reached on Monday through Friday 7:00 - 3:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JP

March 17, 2008

/Joseph E. Avellino/
Primary Examiner, Art Unit 2143